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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LEE, CHEUKFAN

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 04/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



# UNITED STATES PATENT AND TRADEMARK OFFICE

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
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Paper No. 27

## Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment filed on 1-17-02 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on September 8, 2000 (see 65 Fed. Reg. 54603, Sept. 8, 2000, and 1238 O.G. 77, Sept. 19, 2000). In order for the amendment to be compliant, applicant must supply the following omissions or corrections in response to this notice.

THE FOLLOWING ITEMS ARE REQUIRED FOR COMPLIANCE WITH RULE 1.121 (APPLICANT NEED NOT RESUBMIT THE ENTIRE AMENDMENT):

- 1. A clean version of the replacement paragraph(s)/section(s) is required. See 37 CFR 1.121(b)(1)(ii).
- 2. A marked-up version of the replacement paragraph(s)/section(s) is required. See 37 CFR 1.121(b)(1)(iii).
- 3. A clean version of the amended <sup>claims together</sup> claim(s) is required. See 37 CFR 1.121(c)(1)(i).
- 4. A marked-up version of the amended <sup>claims together</sup> claim(s) is required. See 37 CFR 1.121(c)(1)(ii).

Explanation: Please attachment

(LIE: Please provide specific details for correction to assist the applicant. For example, "the clean version of claim 6 is missing.")

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/dcom/olia/pbg/sampleleaf.pdf>. A condensed version of a sample amendment format is attached.

- PRELIMINARY AMENDMENT:** Unless applicant supplies the omission or correction to the preliminary amendment in compliance with revised 37 CFR 1.121 noted above within ONE MONTH of the mail date of this letter, examination on the merits may commence without entry of the originally proposed preliminary amendment. This notice is not an action under 35 U.S.C. 132, and this ONE MONTH time limit is not extendable.
- AMENDMENT AFTER NON-FINAL ACTION:** Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE MONTH or THIRTY DAYS from the mailing of this notice, whichever is longer, within which to supply the omission or correction noted above in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

K. Davis  
Legal Instruments Examiner (LIE)

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**Attachment to Notice of Non-Compliant Amendment (37 CFR 1.121)**

Applicant's response and amendment are confusing and are considered non-compliant.

The clerk could not enter the amendment even with the best of the clerk's and the examiner's understanding of the response.

Applicant has been notified in the letter (PTO-90C) that the amendment (or copy thereof) filed with the petition has not been entered, and therefore, the content of that amendment is not part of the record of the application which the examiner will consider and which Applicant's subsequent response or amendment should refer to. Applicant's current response should not have referred to that amendment which was not entered. However, Applicant's response filed Jan. 17, 2002 is written in a form or way referring to that amendment filed with the petition. **A current amendment or response should be written in a way responsive only to the Office action before the petition, since no response or amendment filed with or after the petition was entered as part of the record that should be considered.** A current amendment or response should not include claims which were withdrawn from consideration in a previous Office action(s) because the Restriction was made final. This was also mentioned in the letter mailed Oct. 24, 2001.

As in some of the previous responses/amendments, the response/amendment filed Jan. 17, 2002 was improper.

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First, currently filed amendment (not entered) lacks a title "AMENDMENT". Whenever there is amendment to any of the drawings, specification, claims, etc., the title AMENDMENT should be used instead of RESPONSE. Do not discuss how the Office action was responded until all requests to amend are listed. Any discussion after the listed request to amend should be proceeded with a title "REMARKS" to show that whatever follows are arguments or discussions (see M.P.E.P.).

Second, that amendment begins with "With respect to the Office Action dated October 24, 2001, kindly amend the above identified application as follows:

Claims 4-7 have been deleted.

Claims 35 is no longer deleted on page 1 and page 16.

Claims 30, 31, 49, 50, 51, and 55 have been deleted."

The above seems like a request to amend the claims. However, the part of the request, namely, "kindly amend the above identified application as follows" is in contradiction with the rest of the request because "have been deleted" means the claims have already been deleted in a previous Office action. For example, "Claims 30, 31, 49, 50, 51, and 55 have been deleted" means that the claims have been deleted in a previous Office action, and it does not mean "Please amend claims 30, 31, ...". However, the PTO record does not show such a request for deleting claims 30, 31, 49, 50, 51, and 55. Therefore, these claims are still pending for examination.

The correct format for requesting that the claims be deleted includes the sentence "Please delete claims 30, 31 ..." after "kindly amend the above identified application as follows:"

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Thirdly, the amendment is non-compliant because on page 2 of the amendment/response, Applicant put in a short section of discussion, i.e., “Claims 27, 28, 29, 32, 33, 34, 35, 40, and 43-48, and 52-54, have been amended to comply with 35 U.S.C. 112, as noted herein. Claims 30, 31, 49, 50, 51, and 55 have been deleted as noted above.” This section should not have been put in before the list of the amended claims; this section should be placed in a discussions section under the title REMARKS which follows the list of amended claims, specification, etc. (in this case, the amended claims). More importantly, the statement “Claims 27, 28, 29, 32, 33, 34, 35, 40, and 43-48, and 52-54, have been amended to comply with 35 U.S.C. 112, as noted herein” is wrongly stated because some of the claim numbers listed in this statement have not been amended, those including claims 44-46. It is important that such statement is correct because the clerk who enters the amendment looks for correspondence between all claim numbers listed in such statement and the claims actually amended in an amendment. The statement stated above does not provide such correspondence which allows the clerk to enter this amendment. It is proper to list all claims including amended claims and non-amended claims, but do not state that all those claims have been amended are amended when there are claims listed but not amended. Further, as discussed above, do not use the terminologies “have been amended herein” before listing the actual amended claims. Use a sentence in a requesting form, such as “please amend the following claims” and immediately list the amended claims.

Lastly, although the amended claims are each written in a clean version and a marked-up version, they are not presented all in a clean version before Applicant’s REMARKS (or

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discussion) and then presented all in a marked-up version which should follow the REMARKS and Applicant's signature. In other words, the marked-up version is only for the purpose of showing the examiner changes to the claim(s). Therefore, marked-up version of all amended claims should be presented on the last page or few pages after Applicant's signature page. Further, the REMARKS section should start with a sentence stating which claims are pending for examination. Please see M.P.E.P.

C. L.

April 17, 2002

(703) 305-4867



Handwritten signature of Cheuk Fan Lee, consisting of stylized characters that appear to be a combination of 'C', 'F', and 'L'.